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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,686	03/10/2000	Takaaki Nagae	1046.1211/JDH	5906
21171	7590	02/26/2004	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			HILLERY, NATHAN	
		ART UNIT	PAPER NUMBER	
		2176	7	

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/522,686	NAGAE, TAKAAKI
	Examiner Nathan Hillery	Art Unit 2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 12 December 2003.  
 2a) This action is **FINAL**.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,4-9,12-17 and 20-24 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,4-9,12-17 and 20-24 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 10 March 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

### DETAILED ACTION

1. This action is responsive to communications: Amendment filed on 12/12/03.
2. Claims 1, 4 – 9, 12 – 17 and 20 – 24 are pending in the case. Claims 1, 9, and 17 independent.
3. The rejections under 35 USC 112, second paragraph, of claims 6, 9 – 24 are withdrawn in view of the new ground(s) of rejection.
4. The rejections under 35 USC 103(a) have been withdrawn as necessitated by amendment.

#### *Priority*

5. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 8/30/99. It is noted, however, that applicant has not filed a certified copy of the 11-243872 application as required by 35 U.S.C. 119(b).

#### *Claim Rejections - 35 USC § 103*

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
7. Claims 1, 4, 8, 9, 12, 16, 17, 20, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson [SinaNet].
8. **Regarding independent claims 1, 9, and 17**, Jackson teaches that *an internet company has developed a system that it claims can receive and read Chinese-language e-mail* (lines 1 – 2), which provide for **receiving a sentence serving as the contents of an electronic mail**. Jackson also teaches that *SinaNet has two coding standards for translating the characters, known as Big-5 for traditional and GB for simplified*. A *Big-5*

*user cannot read text generated by someone using GB and vice versa ... SinaNet's SinaXpress application has modules that translate between Big-5 and GB and make either format into a .GIF file for display on English-language browsers (lines 23 – 28), which provide for forming image data of the sentence when it is judged that the sentence is not text-displayable based on the text data on the basis of the character code system at the destination; and transmitting the electronic mail including the formed image data to the destination of the electronic mail.* Jackson does not explicitly teach **judging whether the sentence is text-displayable based on text data on the basis of a character code system used at a destination of the electronic mail including the sentence**. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to be motivated to judge the sentence so that the invention disclosed by Jackson would transmit as little data as possible over the web for those users with slow connections and limited memory.

9. **Regarding dependent claims 4, 12, and 20,** Jackson teaches that *SinaNet has two coding standards for translating the characters, known as Big-5 for traditional and GB for simplified. A Big-5 user cannot read text generated by someone using GB and vice versa ... SinaNet's SinaXpress application has modules that translate between Big-5 and GB and make either format into a .GIF file for display on English-language browsers (lines 23 – 28), which provide for displaying the sentence on a screen using text data of the sentence wherein, in the forming image data, image data corresponding to the sentence written in a format displayed on the screen is formed.*

10. **Regarding dependent claims 8, 16, and 24,** Jackson does not explicitly teach that the image data is transmitted as an attached file to the destination of the electronic mail. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to know that most Web e-mail services have the capability to attach any file to an e-mail message.

11. Claims 5 – 7, 13 – 15, and 21 – 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson (SinaNet) as applied to claims 1, 4, 8, 9, 12, 16, 17, 20, and 24 above, and further in view of Flanagan et al. [US005966685A].

12. **Regarding dependent claims 5, 13, and 21,** Jackson does not explicitly teach translating the sentence into a language used in the destination when the sentence is expressed by characters written in a language different from the language used in the destination of the electronic mail, wherein translation results are transmitted to the destination of the electronic mail. However, Flanagan et al. do teach that *the present invention is a system of parallel discussion groups operated in conjunction with a message collection/posting software program, data filter software program, and a machine translation software program* (Column 2, lines 21 – 24) and that *some of the messages on a French version of a discussion group will have been originally written in French whereas many will be translations of messages which were originally written in a different language. Each of the messages translated from another language version of the parallel discussion group may contain both the translated message and the original language text. For example, a message originally*

*written in the English version of the discussion group and translated to the French version may be shown on screen with the original English text in addition to the French translation (Column 3, lines 3 – 13). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventions disclosed by Jackson and Flanagan et al. because such a combination would allow the users of SinaNet (Jackson) access to machine translators and other software incorporated to translate messages, thereby creating parallel discussion groups in different languages (Abstract).*

13. **Regarding dependent claims 6, 14, and 22,** the claims incorporate substantially similar subject matter as claims 1, 5, 9, 13, 17, and 21, and are rejected along the same rationale.

14. **Regarding dependent claims 7, 15, and 23,** Jackson teaches that *SinaNet has two coding standards for translating the characters, known as Big-5 for traditional and GB for simplified. A Big-5 user cannot read text generated by someone using GB and vice versa ... SinaNet's SinaXpress application has modules that translate between Big-5 and GB and make either format into a .GIF file for display on English-language browsers* (lines 23 – 28), and Flannagan et al. teach that *some of the messages on a French version of a discussion group will have been originally written in French whereas many will be translations of messages which were originally written in a different language. Each of the messages translated from another language version of the parallel discussion group may contain both the translated message and the original language text. For example, a message originally written in the English version of the discussion group and translated to the French version may be shown on screen with the*

*original English text in addition to the French translation* (Column 3, lines 3 – 13), which provide for **in the forming image data, translated image data of the translation results expressed by characters written in the language used in the destination is formed when it is determined that the characters are not written in the text-displayable language used in the destination of the electronic mail, and the electronic mail transmission method further comprises forming synthesized image data obtained by combining the formed image data corresponding to the sentence with the translated image data, and in the transmitting, the synthesized image data is transmitted to the destination of the electronic mail.** It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventions disclosed by Jackson and Flanagan et al. because such a combination would allow the users of SinaNet (Jackson) access to *machine translators and other software incorporated to translate messages, thereby creating parallel discussion groups in different languages* (Abstract).

***Response to Arguments***

15. Applicant's arguments with respect to claims 1, 9, and 17 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (703) 305-4502. The examiner can normally be reached on M - F, 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NH



JOSEPH FEILD  
SUPERVISORY PATENT EXAMINER